

REMARKS/ARGUMENTS

Claims 1-43 are currently pending in the application. Claims 1-2, 4-6, 8-9, 20-21, 23, 25, 27, 28, 33 and 35-36 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Zegelin (U.S. Published Patent Application No. 2005/0185615) in view of Lee (U.S. Published Patent Application No. 2002/0045424) and U.S. Patent No. 5,063,371 to Oyer et al. Claims 10-13 and 29-32 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Zegelin in view of Lee and Oyer, and further in view of Erskine (U.S. Published Patent Application No. 2004/0166878). Claims 3, 14-17, 22 and 24 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Zegelin in view of Lee and Oyer, and further in view of allegedly well known prior art. Claims 18 and 19 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Zegelin in view of Lee, Oyer, Erskine and allegedly well known prior art.

The Office Action, however, does provide an indication of allowable subject matter. Specifically, the Examiner indicates that claims 7, 26 and 24 would be allowable if rewritten in independent form. The Examiner has allowed claims 37-43.

Applicant respectfully traverses the rejections set forth above for the following reasons. Applicants submit claims 1-43 as previously presented without amendment. Aspects of the claimed embodiments are directed to methods for refreshing signal information in a wireless node location mechanism. The methods and apparatuses provide for selectively terminating the connection between the wireless node and the wireless network for purposes of refreshing signal strength information used to compute an estimated location for wireless clients. The selective terminations are done in response to a request to estimate the location of the wireless node.

The Examiner has failed to establish a prima facie case of obviousness.

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole

would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. Accordingly, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed above, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention.

The M.P.E.P. sets forth the strict legal standard for establishing a *prima facie* case of obviousness based on modification or combination of prior art references. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references where combined) must teach or suggest all the claim limitations." M.P.E.P. § 2142, 2143. The teaching, suggestion, or motivation for the modification or combination and the reasonable expectation of success must both be found in the prior art and cannot be based on an applicant's disclosure. *See Id.* (citations omitted). "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art" at the time of the invention. M.P.E.P. § 2143.01. Even the fact that references *can* be modified or combined does not render the resultant modification or combination obvious unless the prior art teaches or suggests the desirability of the modification or combination. *See Id.* (citations omitted). Moreover, "To establish *prima facie* obviousness of a claimed invention, all the

claim limitations must be taught or suggested by the prior art. All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03 (citations omitted).

The governing Federal Circuit case law makes this strict legal standard even more clear.¹ According to the Federal Circuit, “a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding.” *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). “Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved.” *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the “range of sources available . . . does not diminish the requirement for actual evidence.” *Id.* Although a prior art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.” *In re Mills*, 916 F.2d at 682, 16 U.S.P.Q.2d at 1432. *See also In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (holding a *prima facie* case of obviousness not made where the combination of the references taught every element of the claimed invention but did not provide a motivation to combine); *In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at” the claimed invention.). Even a determination

¹ Note M.P.E.P. 2145 X.C. (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed modification or combination is not sufficient to establish a *prima facie* case of obviousness. See *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, "The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." M.P.E.P. § 2142. The governing Federal Circuit cases are equally clear. "A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.'" *In re Kotzab*, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted). In *In re Kotzab*, the court noted that to prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. See *id.* See also, e.g., *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board, explaining that the required evidence of such a teaching, suggestion, or motivation is essential to avoid

impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted).

A. The Proposed Zegelin-Lee-Oyer-Erskine Combinations Fail to Disclose the Claimed Subject Matter

Here, the combinations of prior art proposed by the Examiner fail to disclose or suggest the subject matter of the pending claims. To support the rejections set forth above, the Examiner relies on a new reference—U.S. Patent No. 5,063,371 to Oyer et al. in combination with Zegelin and Lee. Specifically, as to claim 1 for example, the Examiner admits that neither Zegelin nor Lee disclose "terminating, responsive to the request to estimate the location, the connection between the wireless node and the wireless network." See Office Action at 3. The Examiner alleges, however, that Oyer teaches this limitation. The Examiner essentially injects Oyer into the previous rejections of the claims, as set forth above. Applicants have discussed the other cited references in previous communications and directs the Examiner to the previously filed amendment.

Oyer, alone or in combination with the references identified above, fails to disclose or suggest the present invention. Indeed, the teachings of Oyer come nowhere near the limitations of the present invention, and provide absolutely no teaching relevant to the combinations claimed in the pending claims. Rather, Oyer merely teaches an aircraft

security system including a central control unit coupled to cluster controllers via a two-wire bus. The cluster controllers are operably coupled to various intrusion sensors. See, e.g., Oyer, Col. 4, lines 6-10. Oyer also teaches a hand-held unit that can be used to remotely control the security system and receive warning messages if an alarm condition is detected. According to Oyer, some of the intrusion sensors include an infrared transmitter and receiver. See Oyer, Col. 5, lines 28-41. For example, the transmitter transmits an infrared beam that is detected by the receiver, which outputs a signal to the cluster controller. When the transmitted beam is broken by an intruder, the signal output by the receiver drops, causing an alarm condition. Oyer also teaches a calibration step not relevant to the claimed subject matter.

The Examiner makes a number of unsupportable allegations in connection with Oyer. Notably, neither the passage of Oyer quoted by the Examiner, nor the remaining teachings of Oyer, has anything to do with wireless node location systems according to the pending claims. For example, the "RF radiation" referred to in Oyer addresses the interference caused by the aircraft security system itself, rather than an external source of RF interference. In addition, the Examiner appears to allege that Oyer teaches monitoring the location of wireless devices, and terminating wireless connections between a given wireless node and a wireless network responsive to a request to estimate a location for the wireless node. See Office Action at 4 ("[N]ote that location of wireless devices in the vicinity of sensitive zones are monitored so that they [sic] any unauthorized wireless device within the sensitive zone is detected and they do not pose a threat to the security of the sensitive areas, e.g., airplanes. Thus, location of wireless devices in the vicinity of sensitive areas is monitored by requiring and receiving location information. Further, an additional security requirement for the sensitive areas is terminating the RF connection between the wireless device and the network that it is connected to.").

The Examiner's allegations are flatly unsupportable. Nowhere does Oyer teach monitoring the location of wireless devices. As discussed above, Oyer merely teaches an Infrared-beam-based sensor, whose outputted signal level drops when the beam is broken, thereby triggering an alarm condition. This teaching has nothing to do with terminating a wireless connection, in response to a location request, to refresh signal strength information for a wireless node and thereby improve accuracy of the location determination.

B. The Office Action Fails to Establish a Sufficient Motivation or Suggestion to Combine or Modify the Cited References to Achieve the Claimed Subject Matter

Still further, the Examiner fails to establish a prima facie case of obviousness as the Office Action fails to establish a sufficient motivation or suggestion to combine the references to achieve the claimed subject matter. For example, the Examiner alleges that it would have been obvious to combine the teachings of Oyer with Zegelin and Lee "for the purpose of providing better communication channels by avoiding collisions terminating connections and reassigning channel." This unsupported allegation, however, falls far short of the strict requirements of the M.P.E.P., and governing Federal Circuit case law. For example, given the actual teachings of Oyer, the Examiner's allegation is factually inaccurate and unsupportable, as Oyer has nothing to do with terminating wireless connections between a wireless node and a wireless network. Furthermore, Oyer has nothing to do with a location system that estimates the location of a wireless node.

Moreover, nowhere does the Examiner demonstrate that a person having ordinary skill in the art at the time of the invention would have reasonably expected the proposed combinations to achieve the purported results. First, nowhere does the Examiner demonstrate that the proposed combinations would have in fact produced the purported

results. For example, nowhere does the Examiner even attempt to demonstrate that the combination of the cited teachings in Zegelin and Lee with the security system of Oyer would have achieved the purpose of "providing better communication channels by avoiding collisions terminating connections and reassigning channel." In addition, even assuming for the sake of argument that the proposed combinations would have produced the purported results, nowhere does the Examiner demonstrate that a person having ordinary skill in the art at the time of the invention would have reasonably expected such results. As an example, the Examiner merely asserts that combining the teachings of Zegelin and Lee with the teachings of Oyer would have produced the purported results, without even attempting to demonstrate that a person having ordinary skill in the art at the time of the invention would have reasonably expected such result. If the Examiner intends to rely on information that was generally available to a person having ordinary skill in the art at the time of the invention to demonstrate that the purported results of the proposed combinations would have been expected by a person having ordinary skill in the art at the time of the invention, Applicant respectfully requests that the Examiner provide documentary evidence that such information was in fact generally available to a person having ordinary skill in the art at the time of the invention, as required by the M.P.E.P. and governing Federal Circuit case law.

Applicants also direct the Examiner to the response filed on April 13, 2006 for additional reasons as to why the present rejections are improper.

In light of the foregoing, Applicant believes that all currently pending claims are presently in condition for allowance. Applicant respectfully requests a timely Notice of Allowance be issued in this case. If the Examiner believes that any further action by

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Amdt. Dated August 30, 2006
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Applicant is necessary to place this application in condition for allowance, Applicants request a telephone conference with the undersigned at the telephone number set forth below.

Respectfully Submitted,
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By

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